

Filed by Sally Gardner Lane
Administrative Patent Judge
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Filed: 3 November 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

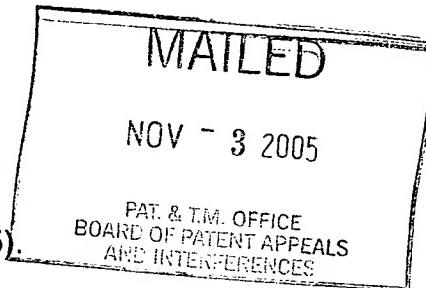
MICHAEL J. ADANG,
JOHN D. KEMP, and EBRAHIM FIROOZABADY

Junior Party,
(Application 08/461,240),

v.

PAUL F. UMBECK,

Senior Party,
(Patents 5,004,863 and 5,159,135).



Patent Interference No. 105,367

DECLARATION - Bd.R. 203(d)

Before Sally Gardner Lane, Administrative Patent Judge.

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

Part B. Judge managing the interference

Administrative Patent Judge Sally Gardner Lane has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

Part C. Standing order

A Trial Section STANDING ORDER [SO] accompanies this DECLARATION.

The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for **2:00 pm on 20 December 2005** (the Board will initiate the call).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER.¹ Counsel are encouraged to discuss the schedule prior to

¹ Interferences are generally conducted in two phases: (1) the “preliminary motions” phase and (2) the priority phase.

A principal goal of the preliminary motions phase is to establish the correct count, to establish the parties’ constructive reduction to practice dates and to determine the subject matter at stake in the interference.

The count is important since it defines the scope of the proofs for proving priority. If a party is dissatisfied with the count, for example, because the party’s best priority proofs are outside the count, a motion to change the count may be authorized.

The accorded constructive reduction to practice dates (“the benefit dates”) are important because they identify the junior party –who has the burden of proof on priority– and the date which the junior party must “beat.” If a party feels that it is entitled to the benefit of the filing date of an earlier application or its opponent is not entitled to the filing date of an application for which benefit was accorded in the declaration, a motion to obtain or attack benefit may be authorized.

The claims designated as corresponding to the count are important because the subject matter of those claims will be lost to the “losing” party. If a party feels that some of its claims which have been identified as corresponding to the count are directed to an invention which is patentably distinct from the count, or that some of an opponent’s claims which were designated as not corresponding to the count are patentably indistinct from the count, then a motion to

the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

A copy of default times for taking action during the preliminary motion phase of the interference accompanies the NOTICE DECLARING INTERFERENCE. Counsel should be prepared to justify altering the default times.

The Board is conducting an electronic filing and a DVD pilot project. Copies of the procedures are attached to this order. Counsel should be prepared to discuss participation in the electronic filing pilot project.

undesignate or designate claims may be authorized.

Additional motions may be authorized during the preliminary motions phase. These include motions challenging the propriety of the interference or a party's standing to contest the interference (e.g., no interference-in-fact between the parties' respective claims, an interference against a patentee is barred by 35 U.S.C. § 135(b), a provoking party does not have written descriptive support for the claims added to institute the interference).

Other motions for unpatentability of involved claims, particularly those claims that will affect the count, may also be authorized. For example, where the count is "Claim 1 or Claim 2 of Jones Patent 5,XXX,XXX" and a party moves for a holding the Jones Claim 1 is unpatentable over prior art, the granting of the motion would necessarily affect the count and would most likely require that the count be modified *sua sponte* to eliminate the unpatentable subject matter.

Part E. Identification and order of the parties

Junior Party

Named inventors: Michael J. Adang
Madison, WI

John D. Kemp
Las Cruces, NM

Ebrahim Firoozabady
Pleasant Hill, CA

Application: 08/461,240, filed 5 June 1995

Title: INSECT RESISTANT PLANTS

Assignee: Mycogen Plant Science, Inc.

Accorded Benefit: US 08/151,399, filed 12 November 1993
US 07/713,624, filed 10 June 1991
US 07/260,574, filed 10 October 1988
US 07/076,339, filed 22 July 1987

Senior Party

Named Inventors: Paul F. Umbeck
Madison, WI

Application: 07/575,035, filed 30 August 1990,
issued as 5,159,135 on 27 October 1992

Title: GENETIC ENGINEERING OF COTTON PLANTS
AND LINES

Accorded Benefit: 06/937,384, filed 3 December 1986,
issued as 5,004,863 on 2 April 1991

Application: 06/937,384, filed 3 December 1986,
issued as 5,004,863 on 2 April 1991

Title: GENETIC ENGINEERING OF COTTON PLANTS
AND LINES

Accorded Benefit: None

Assignee: Aventis Cropscience GMBH and Monsanto
Technology LLC

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1). The senior party is responsible for initiating settlement discussions. SO ¶ 18.

Part F. Count and claims of the parties

Count 1

Claim 62 of Adang (08/461,240)

or

Claim 5 of Umbeck '135 (5,159,135)

The claims of the parties are:

Adang: 52, 53, 56-58, and 61-63

Umbeck '135: 1-7

Umbeck '863 1-16

The claims of the parties which correspond to Count 1 are:

Adang: 52, 53, 56-58, and 61-63

Umbeck '135: 1-7

Umbeck '863 13-15

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Adang: None

Umbeck '135: None

Umbeck '863 1-12 and 16

Part G. Heading to be used on papers

The heading in SO Form 1 must be used on all papers filed in this interference.

See SO ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Sally Gardner Lane)

MICHAEL J. ADANG,
JOHN D. KEMP, and EBRAHIM FIROOZABADY

Junior Party,
(Application 08/461,240),

v.

PAUL F. UMBECK,

Senior Party,
(Patents 5,004,863 and 5,159,135).

Patent Interference No. 105,367

Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

Part I. Required paragraph for affidavits and declarations

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enc:

Copy of STANDING ORDER
Form PTO-850
Copy of claims of Patents 5,159,135 and 5,004,863
Copy of claims of Application 08/461,240
Copy of default times for taking action
Copy of procedures regarding electronic filing
Copy of procedures regarding DVD pilot project

Revised January 2005

cc (via overnight delivery):

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UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

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MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patentee: Umbeck
Application No.: 07/575,035
Filed: 08/30/90, now US Patent
5,159,135, granted 10/27/92
For: Genetic engineering of cotton
plants and lines

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,367.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

Sally Gardner Lane
Administrative Patent Judge